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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,575	07/10/2003	Helmut Kaliebe	4302-031272	4846
	7590 11/14/2003		EXAMINER	
Russell D. Orkin 700 Koppers Building 436 Seventh Avenue Pittsburgh, PA 15219-1818			HWU, JUNE	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/616,575	KALIEBE, HELMUT	
	<b>Examiner</b>	<b>Art Unit</b>	
	June Hwu	1661	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Drawing**

The disclosure is objected to under 37 CFR 1.165(a) because the drawing does not show all the distinctive characteristics of the claimed plant capable of visual representation. The photograph is grainy and blurred. Replacement photograph is requested.

### **Objection to the Disclosure**

#### **37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

#### **35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant application filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties.

More specifically:

A. Section 1612 of the Manual of Patent Examining Procedure states that there is a requirement that "the proposed variety name not be identical with or confusingly similar to other names utilized in the United States or other UPOV member countries for the same or a closely related species." The proposed cultivar name must also be consistent with the requirements set forth in the International Code of Nomenclature for Cultivated Plants -1980.

The U.S. Plant Patent No. 7,724 discloses a golden bronze daisy type chrysanthemum named 'Gold Rush', introduced by Janet S. Fuess. This previous disclosure is drawn to a different plant than the instant plant (note specifically the leaf shape, shape of ray florets, and origin).

As 'Gold Rush', has been previously used as a cultivar name designation for a chrysanthemum plant, it is necessary for applicant to take corrective action relative to the cultivar name of the "instant" plant such as by correcting same as reuse of the cultivar name

'Gold Rush' is inadmissible under at least Article 48, Article 50 and Article 51 of the International Code of Nomenclature for Cultivated Plants - 1980. Article 48 states (in part) that re-use of a previously utilized cultivar name may be permitted by the registration authority (in this case USPTO) "only if the registration authority is satisfied that the original cultivar is no longer in cultivation, has ceased to exist as breeding material or in a gene or seed bank, and is not an important component in the pedigree of other cultivars."

Article 50 states (in part): "Not more than one cultivar may have the same name within the same cultivar class." A cultivar class is set by the registration authority and is defined as "one or more genera, species, subspecies or cultivar groups."

Article 51 states (in part): "When confusion is caused by the use of the same name for two or more widely grown cultivars in the same cultivar class (see Art. 50), the cultivar for which it is the legitimate name is the one selected by a registration authority, or failing this, the cultivar first chosen and published as legitimately bearing the name..."

As plant names are associated with and used to identify particular plants and are therefore descriptive, for a United States Plant Patent to properly issue, the cultivar name set forth in the specification must be acceptable. Applicant must substantively address and obviate this issue responsive to this Office Action, so as to provide as complete a description of the plant as is reasonably possible.

B. Applicant has not sufficiently described the attached photograph. Applicant should set forth in the specification whether a brief description of the attached photograph, such as, if the photograph is of a potted plant or cuttings. Correction is necessary.

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- C. Age of the observed plant should be disclosed in the specification. Correction is required.
- D. Page 2, line 13, the recitation "Rooting habit" should be changed to read -- Root description --.
- E. If available, applicant should set forth in the specification the petiole's surface texture.
- F. Page 4, line 25, the recitation regarding the ray floret's surface texture as "Smooth; glabrous" is unclear if the upper, lower or both surfaces are smooth and glabrous. Clarification is necessary.
- G. Page 5, line 25, the recitation "Light pubescence present" is unclear if the upper, lower or both surfaces are pubescence. Clarification is necessary.
- H. If available, applicant should set forth the filament color designation with reference to an employed color chart.

The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

### **Claim Rejection**

**35 USC § 112, 1st and 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

**Amendments in a Revised Format is Now Mandatory**

Compliance to the revision to 37 CFR 1.121 is mandatory. Complete details to the revised amendment format can be found on the Internet at <http://www.uspto.gov/web/offices/com/sol/og/2003/week08/patform.htm>.

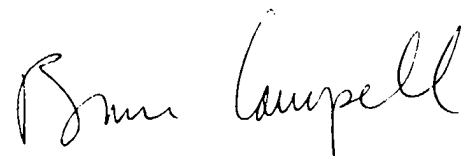
**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (703) 308-5017. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m. and off on Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

JH



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